

REMARKS

This is in response to the non-final Office Action mailed October 28, 2008. In the Office Action, the Examiner notes that claims 16 – 36 are pending and rejected. In view of the following discussion, Applicants submit that all of the pending claims are now in allowable form.

Applicants amended claims 16 – 18 and 31 – 36 to ensure consistency of the terms used. No new matter has been added.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants do not acquiesce to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

35 U.S.C. §112 Rejection of Claims 31 and 35

Claims 31 and 35 are rejected under 35 U.S.C. §112, ¶1 for failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

Applicants would like to draw the Examiner's attention to, for example, the following portion of the Applicants' specification: page 11, line 30 – page 12, line 33. In particular, the cited portion states in part:

"...if, during any period of activity, there are three or more WatchTV events in a row within the SESSION_TIMEOUT, the first two counted but the rest are not. The reasoning behind the rule is that if the first WatchTV event was caused by a key press (i.e., the user is active), then the second one could be caused by a new program starting on the same channel as the first event, but the third is likely to be caused by the TiVo and not the user. That is, there cannot be two consecutive program changes on the same channel without any interactivity on the part of the viewer, or the session timeout rule would be invoked. Thus, three WatchTV events in a row is an indication that the user is asleep and the TiVo (or other PVR) is controlling the events..."

Accordingly, in the stream of command/control signals (such as command signals recorded in a log file of the PVR shown in Table 2, pages 9 – 10), a command/control signal indicative of viewing a television program (such as 'WatchTV' signal) would be classified as caused by a PVR (even though in a

particular case the user's actions could have caused the signal) when such a command/control signal immediately follows two consecutive command/control signals indicative of viewing television programs (such as 'WatchTV' signals), which were classified as caused by the user (e.g., via a remote control). Therefore, Applicants' specification provides full support to subject matter of claims 31 and 35 in such a way as to reasonably convey to one skilled in art the subject matter of the claimed invention.

Accordingly, Applicants respectfully request that the Examiner to withdraw the rejection.

35 U.S.C. §103 Rejection of Claims 16, 19 – 33, and 35 – 36

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141.

The Examiner has rejected claims 16, 19 – 33, and 35 – 36 under 35 U.S.C. §103(a) as being unpatentable over Schlack et al, U.S. Patent No. 7,260,823 (hereinafter "Schlack") in view of Plotnick et al., U.S. Publication No.

2008/0040740 (hereinafter "Plotnick"). Applicants respectfully traverse the rejection.

Applicants respectfully maintain that the Office Action failed to establish a *prima facie* case of obviousness, because Schlack and Plotnick, alone or in combination, do not teach or suggest all the claim elements. In particular, Schlack and Plotnick, alone or in combination, do not teach or suggest at least

"parsing dynamically, in accordance with a set of stored processing rules, a stream of command signals to determine which command signals are associated with a user activated control unit and which control signals are associated with a personal video recorder operation and to generate, using command signals associated with a user activated control unit, information representative of the viewer's viewing behavior, wherein the parsing comprises interpreting at least one signal from the stream of command signals based on the viewer profile,"
as recited in independent claim 16 (emphasis added).

The Examiner acknowledges that Schlack fails to disclose determining "to determine which command signals are associated with a user activated control unit and which control signals are associated with a personal video recorder operation" the highlighted limitation of claim 16 (see Office Action, page 4). However, the Examiner suggests that this limitation taught by Plotnick. In particular, the Examiner states that Plotnick discloses "inserting targeted advertisements when control signals associated with a personal video recorder (STB PVR [0153]) operation such as fast forward, rewind, skip, and pause events see [0170]) are received." The Examiner further states that Plotnick "inherently 'determines which command signals are associated with a user activated control unit and which control signals are associated with a personal video recorder operation' because the alternative advertisements are inserted only during trick play events as opposed to user activated control unit command signals (channel changes and volume changes [0159])" (see Office Action, pages 4 – 5). Applicants respectfully disagree.

First, the Examiner appears to suggest that fast forward, rewind, skip, and pause events are personal video recorder operations while channel changes and volume channels are user activated control unit operations. However, Plotnick

does not support such a classification. In fact, paragraph [0159], cited by the Examiner, states:

“The user interface 628 supplies user events 1030 based on viewer interaction with the remote control and the front panel of the set-top box. These events 1030 include channel changes, volume changes, and VCR-like controls of the PVR”

(emphasis added).

Accordingly, Plotnick treats channel changes events and VCR-like controls of the PVR as members of the same group, user generated events. However, the fast forward, rewind, skip, and pause events are the VCR-like control events (see e.g., paragraphs [0059] - [0061]). Accordingly, in Plotnick, the fast forward, rewind, skip, and pause events and channel changes and volume channels are all user activated control unit operations.

Second, though, as suggested by the Examiner, Plotnick inserts alternative advertisements during trick-play events, Plotnick fails to distinguish between command signals that are associated with a user activated control unit and command signals that are associated with a personal video recorder operation. In fact, nowhere in the cited portions does Plotnick even consider that some of the events may be caused not by a viewer, but actually by a PVR. Rather, Plotnick assumes that all the events, such as channel change events, are user generated events.

In contrast, according to Applicants' claim 1, a command signal may be caused by a viewer or by a PVR. For example, if a user uses a remote control to tune into a particular channel, such a channel-change event is initiated by the user, and thus, a respective command signal should be associated with the user activated control unit. On the other hand, if a PVR, of its own accord, without user's intervention, tunes into a particular channel, a respective command signal should be associated with a PVR operation. Applicants' claimed invention provides for distinguishing between these two types of events. Plotnick, in contrast, assumes that all events, such as channel change events, are user generated events. Accordingly, contrary to the Examiner's suggestion, determining which command signals are associated with a user activated control

unit and which command signals are associated with a personal video recorder operation is not inherent from Plotnick.

Therefore, Schlack and Plotnick, alone or in combination, do not teach or suggest all of the elements recited in independent claim 16, and thus, claim 16 is allowable under 35 U.S.C. §103(a). Independent claim 33 recites relevant limitations, and thus, is allowable at least for the reasons discussed above with respect to claim 16. Because all of the dependent claims include all of the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Schlack in view of Plotnick under 35 U.S.C. §103(a).

Accordingly, Applicants respectfully request that the Examiner to withdraw the rejection.

35 U.S.C. §103 Rejection of Claims 17, 18 and 34

Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schlack in view of Plotnick in further view of Ellis et al., U.S. Publication. No. 2002/0174430 (hereinafter, "Ellis"). Claims 18 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schlack in view of Plotnick in further view of Williamson et al., U.S. Pub. No. 2003/0208767 (hereinafter, "Williamson"). Applicants respectfully traverse the rejections.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. §103(a) given Schlack in view of Plotnick. Since the rejection under 35 U.S.C. §103(a) given Schlack in view of Plotnick has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that the additional references supply that which is missing from Schlack in view of Plotnick to render the amended independent claims obvious, these grounds of rejection cannot be maintained.

Accordingly, Applicants respectfully request that the Examiner to withdraw the rejections.

CONCLUSION

Thus, Applicants submits that all of the claims presently in the application are allowable. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, at (732) 842-8110 x 120, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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